

REMARKS

Claims 10-13, which are directed to a mask having cutout portions pictorially representing different portions of a human face, which overlies receptacles containing cosmetic material, have been rejected over Jackson in view of Geer. Jackson, (as the Examiner has pointed out) does not disclose or suggest the use of a mask having cutout portions pictorially representing different portions of the human face. The Geer reference discloses cutout portions in the form of rectangles . There is no teaching or suggestion in this reference of forming the cutout portions which pictorially represents different portions of the human face as set forth in claims 10-13. The Examiner has contended that it would have been obvious to shape the cutout portions forming the mask in this fashion. It is well established, however, that obviousness cannot be established without some teaching or suggestion in one of the cited references of the inventive combination claimed. As pointed out in the decision of the Court of Appeals for the Federal Circuit in its decision in **ACS Hospital Systems, Inc. v. Montefiore Hospital et al.** (221 USPQ 929; CAF 1974,

Obviousness cannot be established in combining the teachings of the prior art to produce the claimed invention , absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion or incentive to do so.

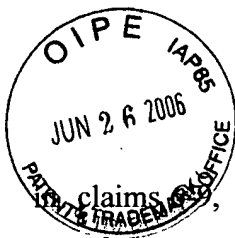
Further, it is well established that hindsight cannot be relied on in finding anticipation. As stated in the decision of the Court of Appeals for the Federal Circuit in its decision in **Iniroyal, Inc. v. Rudkin-Wiley Corp.** 227 USPQ 543:

When prior references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

In view of the lack of teaching or suggestion whatsoever in either of the cited references of Applicant's claimed combination, the rejection of claims 10-13 is believed to be inappropriate.

New claims 14 and 15 are submitted. Claim 14 recites receptacles in the pictorial image of the face portions, these receptacles retaining the cosmetic for the portion of the face pictorially shown. There is no such teaching in Jackson, the receptacles rather merely being in the region of the face involved and not shaped in the pictorial image of the face portions. The provision of receptacles in the shape of the face, which contain the appropriate cosmetic greatly simplifies the use of the device as well as its fabrication and constitutes an improvement neither taught nor suggested by Jackson. It is to be noted that claims 6-9, which have been amended so that they depend from claim 14, define over Jackson for the same reasons as noted above for claim 14. Claim 15 adds another significant feature to applicant's claims, namely a transparent cover through which the images of the face can be seen without opening the case. This feature, which is neither taught nor suggested, by Jackson or the other prior art cited is therefore believed to further patentably define over Jackson .

It is to be further noted that Jackson should also be eliminated as a reference by virtue of Applicant's swearing back Declaration verifying the reduction to practice of the invention set forth in claims 6-9, 14 and 15 prior to the filing date of the Jackson application. With Jackson eliminated as a reference with regard to the invention set forth



claims 6-9, 14, and 15, not disclosed or claimed by Jackson, are believed to be in condition for allowance.

It is therefore submitted that Applicant's claims 6-9, 14, 15 and 10-13 are in condition for allowance and such Action is respectfully requested. If the Examiner has any questions with regard to this amendment or suggestions for further amendment, it would be appreciated if he would telephone Applicant's Attorney so that such matters can be expeditiously resolved.

Respectfully Submitted

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Signed

Douglas M. Kautzky